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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,420	03/11/1999	ALFRED ALASIA	1455.028	7018

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J Micheal Martinez de Andino Esq
Hunton & Williams
Riverfront Plaza
951 East Byrd Street
Richmond, VA 23219-4074

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 05/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,420

Applicant(s)

ALASIA, ALFRED

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
4a) Of the above claim(s) 37-45 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-36, 46 and 47 is/are rejected.
7) ☒ Claim(s) 48 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 1, 6, 7, 10, 15, 16, 19, 24, 25, 28, 33, 34 have been amended for further examination. Claims 46-48 have been added.

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Election/Restriction

2. This application contains claims 37-45 which are drawn to an invention nonelected with traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

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U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 9-15, 18-24, 27-33, 36, 46, 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al (WO-98/15418).

Taylor et al disclose in Fig. 1-4, a self-authenticating article comprising: a plastic paper substitute (2) which can be in the form of a banknote or travelers checks, or the like having indicia (4) printed on the plastic paper substitute; authenticating means is a decoding lens (optical metamer filter) for revealing encoded hidden indicia (Page 15, lines 7-19) which comprises one or more latent images (Page 4, lines 25-30), wherein the means forms a unitary and integral structure in combination with the plastic paper substitute; wherein the authenticating area (5) is positionable in juxtaposed relation to the hidden indicia thereby providing instant verification of the authenticity of the article (page 15, lines 17-19).

In regards to Claims 3-6, 12-15, 21-24, 30-33, and 46, the patentability of a product does not depend on its method of production. If the product in the product-by process claims is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, the lens and latent images can be produced and configured by any desired process.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-8, 16, 17, 25, 26, 34, and 35, are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (WO 98/15418).

Taylor et al disclose a self-authenticating article comprising all the elements as disclosed in Claims 1, 10, 19, 28, and 45, and as set forth above. However, Taylor et al does not disclose wherein the plastic paper substitute is selected from the group consisting of synthetic resin films having a high degree of writablity and printability, laminate composite structures including combinations of paper and non-paper materials, latex saturated durable papers, coated polyolefin substrates formed from randomly dispersed and bonded polyolefin filaments, reinforced papers, and combinations thereof; encoded hidden indicia in accordance with parameters set forth by a computer implemented software program; latent images being encoded in accordance with particular parameters whereby decoding is achieved by a particularly programmed authenticating means.

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In regards to **Claims 7, 16, 25, and 34**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired encoded hidden indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of display arrangement does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would be obvious to use any type of indicia, since applicant has not disclosed the criticality of using a particular type of indicia (in accordance with parameters set by a computer software program, and invention would function equally as well with any type of hidden encoded indicia.

In regards to **Claims 8, 17, 26 and 35**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the article in any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the plastic paper substitute with any desired components, since applicant has not disclosed the criticality of using particular material components, and invention would function equally as well with any component material.

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Allowable Subject Matter

6. Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Knop et al, Mowry et al, and Menz et al discloses similar authenticating documents.

Response to Arguments

7. Applicant's arguments filed on March 2, 2004 have been fully considered but they are not persuasive. In response to applicant's argument that the Taylor reference does not disclose an authenticating means for revealing encoded hidden indicia printed on a surface in which the indicia is scrambled or encoded so that the optical characteristics of the window serve to reassemble the

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indiciated image, the examiner submits that Taylor et al does indeed disclose hidden indicia (Page 15, lines 15-19, wherein a "second portion is hidden in an opacifying coating under reflected light". Taylor et al also discloses that the indicia discloses encoded indicia wherein encoded indicia is considered a broad term which can mean any type of indicia not readable with the naked eye. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired encoded hidden indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of display arrangement does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would be obvious to use any type of indicia, since applicant has not disclosed the criticality of using a particular type of indicia (in accordance with parameters set by a computer software program, and invention would function equally as well with any type of hidden encoded indicia. Therefore, the rejection has been maintained.

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Conclusion

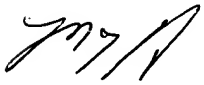
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 17, 2004



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700